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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,320	11/16/2001	Francis M. Lacan	CHA920010022US1	8419

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EXAMINER
CERVETTI, DAVID GARCIA

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/988,320	LACAN ET AL.
	Examiner	Art Unit	
	David G. Cervetti	2136	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>*14 September 2006*</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>*1-24*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>*1-24*</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>*14 August 2006*</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments filed September 14, 2006, have been fully considered.

2. Claims 1-24 are pending and have been examined.

Response to Amendment

3. The objections to the drawings are withdrawn.

4. The objection to claim 12 is withdrawn.

5. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new ground(s) of rejection.

6. The applicant has not traversed the examiner's use of official notice with regards to the claimed limitations found in claim 5, these features are taken by the examiner to be admitted prior art since the applicant has not adequately challenged the examiner's use of official notice (see MPEP 2144.03(c), 2144.04).

Continued Examination Under 37 CFR 1.114

7. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Claim Objections

8. Claims 1, 12, 16, and 20 are objected to because of the following informalities: "proformed", perhaps "performed" was intended. Appropriate correction is required.

9.   Claim 20 is objected to because of the following informalities: "A program product

stored on a recordable medium for managing data, which when executed, comprises:".

Perhaps "A program product, stored on a recordable medium, for managing data, which

when executed, comprises:" was intended. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

11.   Claims 1, 6, and 20 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

Claims 1, 6, and 20 recite the limitation "the received data". There is insufficient

antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

12.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

13.   Claims 20-24 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

Claim 20 are not limited to tangible embodiments. In view of applicants'

disclosure, specification page 8, lines 7-19, the medium is not limited to tangible

embodiments, instead being defined as including both tangible embodiments (e.g.,

Memory 12 may comprise any known type of data storage) and intangible embodiments

(e.g., and/or transmission media). As such, the claim is not limited to statutory subject

matter and is therefore non-statutory. Claims 21-24 are rejected based on their

dependency from claim 20.

14.   To expedite a complete examination of the application, the claims rejected under

35 U.S.C. 101 (non-statutory) above are further rejected as set forth below in

anticipation of applicant amending these claims to place them within the four statutory

categories of invention.

Claim Rejections - 35 USC § 102

15.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

16.   **Claims 1, 3, 4, 6, 7, 11, 20, and 22-24 are rejected under 35 U.S.C. 102(e) as**

being anticipated by Lei et al. (US Patent 6,487,552, hereinafter Lei).

Regarding claims 1 and 20, Lei teaches

a data management system **(abstract)**, comprising:

- an access control system for limiting access to the data management
system to authorized entities **(summary)**;

- a data confidentiality system for identifying details in the received data as
one of secret, temporarily secret, possibly secret, and not secret, wherein
secret, temporarily secret and possibly secret comprise confidential
details and concealing confidential details in received data while allowing
an analysis to be proformed that is based on the confidential details **(col.
1, lines 20-60)**;

- a data storage system for storing the received data **(col. 5, lines 8-67,
hardware overview)**; and

- a data update system for periodically automatically examining stored
data to identify and expose any confidential details that have become
non-confidential details **(col. 9, lines 1-67, defining and setting context
attributes)**.

Regarding claims 3 and 22, Lei teaches wherein stored data is analyzed with a
data analysis system **(functional overview)**.

Regarding claims 4 and 23, Lei teaches wherein the data analysis system is
permitted to analyze the stored data based upon approval by full rights members of the
data management system **(functional overview)**.

Regarding claims 6 and 24, Lei teaches wherein the received data and the stored data are operational risk data **(col. 1, lines 20-60, col. 9, lines 1-67, defining and setting context attributes)**.

Regarding claim 7, Lei teaches wherein the system mitigates operational risk **(col. 1, lines 20-60, col. 9, lines 1-67, defining and setting context attributes)**.

Regarding claim 11, Lei teaches a customer relationship management tool for verifying a policy of an entity **(col. 16, Policy Function section)**.

Claim Rejections - 35 USC § 103

17.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

18.   **Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lei, and further in view of Admission.**

Regarding claim 5, Lei does not expressly disclose wherein data management system is a tamper resistant, tamper evident, tamper sensitive, tamper reactive, and programmable system. However, these features have been admitted per applicant to have been conventional and well known at the time the invention was made by the failure to adequately challenge the examiner's use of official notice in a previous office action.

19.   Claims 2, 8-10, 12-19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lei, and further in view of Singhal (US Patent 6,938,022).

Regarding claim 12, Lei teaches a data management system **(abstract)**, comprising: an access control system for limiting access to the data management

system to authorized entities **(summary)**; a data confidentiality system for identifying

details in the received data as one of secret, temporarily secret, possibly secret and not

secret, wherein secret, temporarily secret and possibly secret comprise confidential

details and concealing confidential details in the received data while allowing an

analysis to be proformed that is based on the confidential details **(col. 1, lines 20-60)**; a

data storage system for storing received data after the confidential details have been

concealed **(col. 5, lines 8-67, hardware overview)**; a data update system for

periodically examining stored data to identify and expose any confidential details that

have become non-confidential details **(col. 9, lines 1-67, defining and setting context

attributes)**; a program approval system for approving systems for analyzing the stored

data **(col. 8, lines 32-67)**. Lei does not expressly teach, however Singhal does teach a

data decryption system for receiving at randomly generated time intervals and

decrypting received operational risk data **(col. 7, lines 1-67)**; and a key security system

for protecting encryption keys **(col. 15, lines 17-67)**. Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to

apply the teachings of Singhal to the system of Lei. One of ordinary skill in the art would

have been motivated to do so to provide data confidentiality **(Singhal, abstract,

background)**.

   Regarding claim 16, Lei teaches a method for managing data **(abstract)**,

comprising: identifying details in the received data as one of secret, temporarily secret,

possibly secrete and not secret, wherein secret, temporarily secret and possibly secret

comprise confidential details and concealing confidential details in the received data

while allowing an analysis to be proformed that is based on the confidential details **(col. 9, lines 1-67, defining and setting context attributes)**; storing the received data **(col. 5, lines 8-67, hardware overview)**; and updating the stored data by identifying and exposing any confidential details that have become non-confidential details in the stored data **(col. 9, lines 1-67, defining and setting context attributes)**. Lei does not expressly teach, however Singhal does teach receiving operational risk data at randomly generated time intervals in a secured manner from an authorized provider **(col. 7, lines 1-67)**. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teachings of Singhal to the system of Lei. One of ordinary skill in the art would have been motivated to do so to provide data confidentiality **(Singhal, abstract, background)**.

Regarding claims 2, 17, and 21, Lei teaches a program approval system for approving systems for analyzing the stored data **(col. 8, lines 32-67)**. Lei does not expressly teach, however Singhal teaches a data decryption system for decrypting received data **(col. 7, lines 1-67)**; a data verification system for verifying an accuracy of received data **(col. 7, lines 1-67)**; and a key security system for protecting encryption keys **(col. 15, lines 17-67)**. The reason for combining is the same as that for claims 12 and 16 above.

Regarding claim 8, Lei does not expressly disclose, however Singhal teaches wherein data is received based upon a randomly generated time interval **(col. 7, lines 1-67)**. The reason for combining is the same as that for claims 12 and 16 above.

Regarding claim 9, Lei does not expressly disclose, however Singhal teaches wherein the confidential details cannot be accessed by any entity **(col. 7, lines 1-67)**. The reason for combining is the same as that for claims 12 and 16 above.

Regarding claim 10, Lei does not expressly disclose, however Singhal teaches wherein the confidential details can only be accessed by a plurality of entities acting in concert **(col. 7, lines 1-67)**. The reason for combining is the same as that for claims 12 and 16 above.

Regarding claims 13 and 18, the combination of Lei and Singhal teaches wherein stored data is analyzed with a data analysis system **(Lei, functional overview)**.

Regarding claims 14 and 19, the combination of Lei and Singhal teaches wherein the data analysis system is permitted to analyze the stored data based upon approval by full rights members of the data management system **(Lei, functional overview)**.

Regarding claim 15, the combination of Lei and Singhal teaches wherein a provider submits the operational risk data to the data management system, and wherein a requester accesses the stored data **(Lei, col. 1, lines 20-60, col. 9, lines 1-67, defining and setting context attributes)**.

Conclusion

20.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent Application Publication 2004/0049679 to Meggle disclose using a tamper resistant/tamper evident authentication device. US Patent

Numbers 6,224,486 and 6,425,828 to Walker et al. disclose the use of tamper evident/resistant/reactive/sensitive systems/memory.

21.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

22.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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11/24/06